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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/872,914	06/01/2001	Ferdinand Schermel		4663

7590

02/24/2004

Ferdinand Schermel
RR# 10
Brampton, ON L6V 3N2
CANADA

EXAMINER

CASTELLANO, STEPHEN J

ART UNIT	PAPER NUMBER
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3727

39

DATE MAILED: 02/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/872,914

Applicant(s)

SCHERMEL, FERDINAND

Examiner

Stephen J. Castellano

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-6,9,10,22 and 24-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-6,9,10,22 and 24-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 April 2002 and 29 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claims 2, 8, 11-16, 18-20 and 23 have been canceled. Insofar as the text of claims 7, 17 and 21 have not been submitted in the latest amendment and are identified as "not entered," claims 7, 17 and 21 will not be treated according to their merits. Please clarify that these claims have been canceled in the next response. An action on the merits of claims 1, 3-6, 9, 10, 22 and 24-26 follows:

Manner of Making Amendments

Applicant must double space the lines of any text in an amendment whether the text is in the written specification, the claims or an abstract. Also, applicant must use an appropriately sized lettering such as 12 point or larger as the size used is too small to decipher punctuation when a facsimile copy is transmitted. Also, applicant should submit amendments in accordance with 37 CFR 1.121.

Specification

The use of the trademark RUBBERMAID has been noted in this application. It should be capitalized wherever it appears (capitalize every letter) and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

The examiner suggests that appropriate generic terminology for the term RUBBERMAID could be "a plastic trash receptacle."

Drawing Objections

The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on April 24, 2002 as a portion of amendment A filed on April 24, 2002 have been disapproved because they introduce **new matter** into the drawings. 37 CFR 1.121(f) states that no amendment may introduce new matter into the disclosure of an application. The original disclosure does not support the showing of five containers attached together as shown in Fig. 1. Further reasoning is given in the Office letter mailed August 8, 2003 as paper No. 27, in paragraph 5, proposed Fig. 1 shows “a specific arrangement of the containers, specific connections between containers, specific sizes of the containers, a specific number of containers, etc.” These additional details which are shown in Fig. 1 are new matter.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the modular wheeled container system comprising a wheeled container, a first attachable container which rest on top of the wheeled container and a second attachable container which rest on top of the first attachable container as claimed in claim 1 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

In addition, all of the limitations of claims 3-6, 9, 10, 22 and 24-26 must also be shown in the same figure or corresponding figures.

The drawing figures submitted December 29, 2003 as part of the amendment of paper No. 33 are similarly disapproved as containing **new matter**.

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A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Objections

Claims 1, 3-6, 9, 10, 22 and 24-26 are objected to because of the following informalities: Claim 1 recites structure pertaining to a modular wheeled container system comprising a wheeled container, a first attachable container which rest on top of the wheeled container and a second attachable container which rest on top of the first attachable container which has not been shown in the drawings.

Appropriate correction is required. Appropriate correction may include the cancellation of the claim(s) or the removal of the objectionable portion of the claim(s). Do not submit new matter.

112 Rejections

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 3-6, 9, 10, 22 and 24-26 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

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The specification as originally filed doesn't contain support for a modular wheeled container system comprising a wheeled container, a first attachable container which rests on top of said wheeled container and a second attachable container which rests on top of said first attachable container as recited in claim 1. Also, the base perimeter greater than 55 inches as recited in claim 1 is not supported by the original specification. **This is a new matter rejection.**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3-6, 9, 10, 22 and 24-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is indefinite because it contains an optional limitation, "an optional second attachable container." The metes and bounds of the claim, that is, the scope of the claim can not be determined since it can't be determined if the second attachable container is part of the claim or not.

Claim 1 contains the limitation "the a base perimeter" in line 26. There is no antecedent basis for this term. Claim 1 is confusing because it can't be determined whether applicant is introducing the "base perimeter" element or referring to a previous recitation of the "base perimeter."

Art Rejections

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tiramani 1 ('559) and Tiramani 2 ('847).

Each of the Tiramani references disclose the invention except for capacity of the container of 32 gallons and the base perimeter of 55 inches. Trash containers of 32 gallon capacity and 55 inch base perimeter are well known. It would have been obvious by engineering design choice to modify the size of the container to be 32 gallons in order to make the volume correspond to any quantity desired. No criticality has been assigned to the 32 gallon capacity. It would have been obvious by engineering design choice to modify the size of the base perimeter to be greater than 55 inch to have a base which is large enough in perimeter and area to be stable to be stacked upon without concern of the stack toppling. No criticality has been assigned to the 55 inch perimeter dimension.

Claims 3-6, 9, 10 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tiramani 1 and Tiramani 2 in view of Tolbert, Jr. (Tolbert).

The Tiramani references disclose the invention except for the additional wheeled container secured to an attached container. From the Tiramani references, it is well known that the combination of a wheeled container with an attachable container is old and well known. Tolbert teaches a plurality of side-by-side wheeled containers which are connected by their handles and roll together as a single entity in a tilted position. It would have been obvious to add another wheeled container with an attachable container by duplication of part and as taught by the Tiramani references and to connect the two wheeled containers by their handles as taught by

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Tolbert to provide a single entity which can be rolled in a tilted position as a single entity eliminating the need to make a trip with each container individually to transport all the containers to the same point from the same point.

Claims 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tiramani 1 or Tiramani 2 in view of Tolbert as applied to claim 6 above, and further in view of Ferbrache.

The combination discloses the invention except for the specific handle of Ferbrache. Ferbrache teaches the handle of Ferbrache. It would have been obvious to modify the connection between the containers to be the handle of Ferbrache in order to provide a means for easy lifting by handle grasping, as well as, a latch in the same assembly to enhance the transportability and storage without adding parts.

Note that applicant states that the species contained in this application are not patentably distinct and unpatentable over each other in lines 8-10 of the request for supervisory review filed February 3, 2003 as paper No.23. The claims are additionally obvious for this reason.

Response to Arguments

Applicant states that he "is unclear to the date of reduction of practice of the details of Tiramani patent" (Tiramani 6,176,559). The date of reduction of practice or the date applicant actually made this device is irrelevant. Tiramani (6,176,559) was filed on November 4, 1999. In addition, Tiramani (6,176,559) is a continuation application of application serial No. 09/017,197 filed February 2, 1998. Since no new subject matter may be added once an application is filed, Tiramani (6,176,559) shows possession of the invention at least back till February 2, 1998.

Likewise, Tiramani (6,347,847) shows possession of the invention at least back till February 2, 1998.

Applicant has request reconsideration of the determination of new matter in the drawing amendment filed April 24, 2002 because it is his belief that the phrase "at least one" in claim 1 originally filed ("at least one attachable container") is being misinterpreted and too narrowly construed. The Office agrees that "at least one" encompasses and includes "more than one." Applicant believes that any arrangement where more than one attachable container is shown is supported. However, this is not true. Applicant is limited to the configurations originally disclosed when the application was filed, not what was disclosed before in a provisional application and not what was conceived of after the file date.

Insofar as applicant's argument is understood with respect to "tilted hitching," applicant believes that hitching refers to the connection of vertically adjacent containers in a stack as stated in the first paragraph of the "Art Rejections" section on page 19. As originally disclosed by applicant's specification, "hitching" refers to the side-by-side connection of horizontally adjacent wheeled containers. Tolbert teaches the side-by-side connection of horizontally adjacent wheeled containers by a hitch or hitching connection.

Applicant requests that written specific details be provided regarding the issues in this case. The examiner has provided written specific details in this action and through out the prosecution of this application.

Action is Final

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen J. Castellano whose telephone number is 703-308-1035. The examiner can normally be reached on M-Th 6:30-5.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lee W. Young can be reached on 703-308-2572. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Stephen J. Castellano
Primary Examiner
Art Unit 3727

sjc